

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: BARTLETT, et al.
Serial No.: 10/511,461
Filed: October 14, 2004
For: Arrangement for Cooling a Roll
Group Art Unit: Not yet assigned
Attorney's Docket No. 13058N/041750
Customer No. 32885

PETITION UNDER 37 C.F.R. § 1.47(a)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

November 22, 2005

12/01/2005 LLANDGRA 00000054 10511461

02 FC:1464

Dear Sir: 130.00 OP

The Assignee of the present application respectfully petitions to have the Declaration of one of two inventors in the above case accepted without the signature of the second inventor. The second inventor, Steve Corcoran has refused to sign an Oath or Declaration.

The Declaration points out that Mr. Corcoran has reviewed the application and was requested to sign an Oath or Declaration. On several occasions, Mr. Corcoran indicated orally and in writing that he was not going to sign a Declaration. The written communications received from Mr. Corcoran are attached to the Declaration.

The evidence presented in connection with this Petition is sufficient to show that the Assignee has made the necessary effort to have inventor Corcoran sign the Declaration, but that he refused to do so.

As background information to accompany the Declaration evidence, the non-signing inventor and the Assignee have a history. Mr. Corcoran, a student at the University of Whales Institute, was employed by the Assignee to design, develop, and test a new range of rotational union couplings (RCU) products. The material of the present patent application was invented by Mr. Bartlett and Mr. Corcoran as part of this program.

UK Patent Application 0208639.5, from which this application claims priority, was filed in the name of Mr. Bartlett and Mr. Corcoran as joint inventors. An entitlement proceeding in the UK transferred rights to the invention to the Assignee (named as the Applicant), and named Mr. Bartlett and Mr. Corcoran inventors.

Additionally, Mr. Corcoran's departure from the Assignee was not on the best terms.

It is clear from the emails attached to the Declaration that hard feelings remain between the non-signing inventor and the Assignee.

A diligent effort has been made to obtain the non-signing inventor's signature, and it is clear that additional efforts, at least in the short term, will be fruitless. As indicated in the email, the non-signing inventor is non even attempting to charge the Assignee exorbitant fees for reviewing the Declaration and/or providing his signature. At this point, additional inquiries would apparently only result in additional unreasonable invoices for the Assignee.

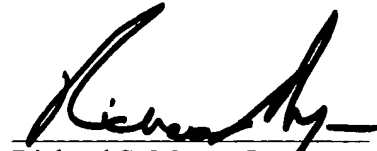
Assignee acknowledges that the emails from the non-signing inventor raise issues of inventorship. The matter has been looked into, and the current understanding is that the inventorship as listed (with the two inventors) is correct.

In light of the evidence provided herein, the Assignee has provided the necessary information for the USPTO to accept the Declaration in this case from one of the inventors pursuant to 37 C.F.R. 1.47(a).

The required fee under 37 C.F.R. § 1.47(a) is submitted herewith.

Should there be any questions in connection with this Petition or the Application in general, please contact the undersigned at the number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Richard S. Myers, Jr.", written over a horizontal line.

Richard S. Myers, Jr.
Registration No. 42,822
STITES & HARBISON, PLLC
424 Church Street, Suite 1800
Nashville, TN 37219
(615) 244-5200
ATTORNEY FOR APPLICANT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: BARTLETT, et al.
Serial No.: 10/511,461
Filed: October 14, 2004
For: Arrangement for Cooling a Roll
Group Art Unit: Not yet assigned
Attorney's Docket No. 13058N/041750
Customer No. 32885

DECLARATION UNDER 37 C.F.R. § 1.47(a)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

On behalf of the Assignee of the present application, Bartlett Engineering, the undersigned states that in order to obtain an executed Declaration in conjunction with the above-identified application, the Inventors' Declaration and Assignment was forwarded to both inventors of the above-identified application, namely Michael Charles Richard Bartlett and Steven Phillip Corcoran. Although the executed Declaration and Assignment was obtained from inventor Bartlett, no Declaration or Assignment was ever obtained from inventor Corcoran.

The Declaration and Assignment documents were filed in the USPTO without Mr. Corcoran's signature.

As deadlines approached for responding to the Notification of Missing Requirements mailed April 22, 2005, I contacted Mr. Corcoran by telephone to request that he sign the Declaration that was previously forwarded to him. On November 15, 2005, Mr. Corcoran left a voicemail message for me, stating "I will not present my signature on the documents." On the following day, I had a telephone conversation with Mr. Corcoran. He again unequivocally refused to sign the declaration.

On November 17, 2005, I received the email from Mr. Corcoran that is attached hereto as Attachment I. Attachment I clearly shows Mr. Corcoran's steadfast refusal to sign the Declaration.

Following the receipt of the November 17, 2005 email from Mr. Corcoran, I forwarded him another copy of the application filed in the United States, and requested that he confirm his continued refusal to sign the Declaration (Attachment II).

The reply to this final request to sign the Declaration is the email attached as Attachment III. Mr. Corcoran's reply makes it clear that he received my email and attachments, since my email was returned attached to his reply. Additionally, in the reply Mr. Corcoran is clear in that he is refusing to sign the Declaration at this time.

Therefore, despite the fact that the inventors' Declaration and the above-identified application were provided to inventor Corcoran, he refuses to execute the Oath for this application and no Oath from him has been received.

The attached emails evidence that this inventor refuses to sign the Declaration provided to him, and that further attempts would be fruitless at this time.

The last known address for the inventor, Steven Phillip Corcoran, who refused to execute the Declaration is as follows:

22 Great Close, Crowood, Yorkshire YO8 3UG (Great Britian).

I hereby state that all statements made herein based on my own personal knowledge are true and correct and that all statements based on my information and belief are true and correct to the best of my knowledge, and further that all of these statements have been made with the knowledge that willful false statements are the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

November 21, 2005
Date

By: 

Name: Richard S. Myers, Jr.

Title: Attorney for Applicant

ATTACHMENT I

Myers, Richard S.

From: Steve Corcoran [steve.corcoran@corcost.com]
Sent: Thursday, November 17, 2005 2:35 AM
To: Myers, Richard S.; teb@udl.co.uk; vjs@udl.co.uk
Subject: Ref; 1007 (P000) Mail

Richard;

The simple fact is I do not believe the statement to be true i.e. I do not believe MB to be an inventor; thinking back to what happened previously, I believe that MB gained the inventor status as part of his duties as MD of Bartlett Engineering; your American forms refer to the product.

I think that looking at the forms you have produced; they are not the same as the US PTO forms, from memory a form 7/77 was not completed in this country and I do not think that all is very clear cut and thus without the aspects being clear I feel that an application of signature would not be a considered move on my part and open the patent to invalidation.

I believe MB was awarded inventor status with a move to Bartlett Engineering becoming the applicant, a move that I did not oppose; however, at the time I submitted the various documents to the patent to reference some of the notes involved; MB became inventor by proxy in that it was considered in his duties as CEO of the company; my patent agent stated that to claim inventor status they would need to be clear evidence of invention.

The one thing that made it worse is the time constraints involved in this particular instance; I can see the patent on the world site and I believe with some carefully crafted claims then the IP value of the unit will be much improved i.e. the overall scope increased and thus the value increased. However, it sparked me thinking about the design and the interaction of MB with the process and I cannot say that he started/delivered any of the design features.

It is relevant that the signature of MB has already been applied to the forms and thus I cannot ignore that fact; if MB's signature had been applied to the forms and I was asked to submit the forms as is with just my signature and the if MB signed after, then I would have signed in good faith; however, in this context it is a factor that I cannot ignore.

I would not wish to harm the patent, however, the manner in which this has been handled is not conducive to good practise and thus I have to protect myself and make sure I have done the right thing by me; I will further consider the instance of writing a letter to the US PTO to clarify my position and make sure my words are placed with reference to the patent application; in that way I have no reason to worry about misrepresentation of Corcost or my name.

With regards to me "possibly joining the persecution team" i.e. you guys, this would cost a huge amount of money and would pull me from my other work, thus not only would the timing need to be correct but also my time would need to be covered; the time to complete claims assessment properly would be approx. one week and would run to approx. £20K or \$34K USD plus incurred expenses; this excludes any input with regards to "assignment" fees and or continued dealings with the patent i.e. to apply my signature to other forms for other countries; this would incur further cost but this could be enrolled into the "assignment" fees.

As said this is on the assumption that I could offer the time to the project, which with all my other business dealings will be tricky. As you have referenced to me, you stated last night on the telephone that by not signing the forms [due to lack of time to assess and sort out etc] I do not lose any rights as an inventor associate or any other and or potential rights associated; it is just a shame that this route was taken by UDL and Bartlett's.

Wishing Bartlett's and the patent all the best; thanks

11/17/2005

Steve

11/17/2005

ATTACHMENT II

Myers, Richard S.

From: Myers, Richard S.
Sent: Thursday, November 17, 2005 11:31 AM
To: 'Steve Corcoran'
Subject: RE: Ref; 1007 (P000) Mail

Steve:

Attached is a copy of the application from our end.

As you will see, it is the same as that which you previously reviewed.

Please confirm that you will continue to refuse to sign the Declaration and Power of Attorney.

Thanks,
Richard

Richard S. Myers, Jr.
STITES & HARBISON PLLC
424 Church Street, Suite 1800
Nashville, Tennessee 37219
Phone: 615-782-2333
Fax: 615-782-2371
richard.myers@stites.com

11/17/2005

ATTACHMENT III

Myers, Richard S.

From: Steve Corcoran [steve.corcoran@corcost.com]
Sent: Thursday, November 17, 2005 2:38 PM
To: Myers, Richard S.; vjs@udl.co.uk
Subject: RE: Ref; 1007 [guest] (P000) Mail

Richard;

Note; Vicky, as stated I would notify you as to which of the rates is applicable [see the Ps at the end of the mail]; I will confirm this by invoice tomorrow.

I am not being funny, but I did not say that i.e. I did not say that I would continually refuse to sign, on this occasion I have not had the time to sort anything out and thus how can I decide; simple fact is that I cannot.

Also the forms that you are asking me to sign would be conducive to a lie, as I understand from my patent attorney MB should have placed some degree of inventiveness into the product regardless and thus I cannot sign; MB was rarely even present and thus with all this, I cannot commit a signature on this occasion.

You left me little time for this to be done and you stated that I could join at any time in the future as inventor and that there was no time limit, thus I have no reason to rush such a decision; the onus is not on me to produce the relevant documents at the relevant times, that is down to you, UDL and Bartlett Engineering otherwise you are derelict in your duties and subsequently not taking reasonable responsibilities and commitments to actions; see "of sound body and mind" below.

I understand from what you previously stated I could declare invention status later down the line and you also referenced the choice of patent attorney and letters confirming that I am not liable for any cost thereof with declaration of power of attorney; as such it is difficult for me to sign; again that is UDL and your concern.

I think it is also interesting that UDL declared MB of "sound body and mind" and in "pursuit of his duties as MD" with regards to the patent and thus the agreement signed [where I receive 10%] would also constitute as statement of sound body and mind, as would all MB's actions prior and or during and or post; patent, unless cause that state of mind and or body has altered; like the handling of this situation as a classic example.

It is also difficult for me to sign as is with regards to MB's signature i.e. MB's signature was applied first to the statement, a better approach would have been to have my signature placed on the declaration first without MB's signature then if MB decides to apply his signature, then that is up to MB and not my concern; from advise I have taken it seems that without the issues being addressed the patent should not really proceed; again this is not my call.

Also if I recall correctly a form 7/77 was not signed with relation to the patent; the form 7/77 declares inventor status; maybe my memory does not serve me well but I do not recall such a form being signed; **so I need a letter from you and UDL that I am liable for no cost in association** with this patent and declaration, as I requested; I need to have all aspects fully checked out by my legal team and I have not had enough time to consider the signature and the required statements etc at this time/on this occasion, this is not my concern and or making and it casts shadows and builds history as to "of sound body and mind statements"; if I was the patent agent, I would be concerned; however, I am not and as such am not.

11/17/2005

Thus and as we said on this occasion without information that I have asked for [it is only today that I actually received the full documentation] how can I sign on this occasion? But I make it clear that I did not say that I would not ever sign and or I did not say that I would continually refuse to sign; hope this clears it all up; see invoice notes below.

Thanks
Steve

Ps; please can you inform UDL that this mail reply is set at the highest UDL rate i.e. £800 per hour and the minimum charge is two hours; thus the total for this reply is £1600 plus VAT; the total UDL bill now outstanding is £5600 plus VAT.

Thanks
Steve

From: Myers, Richard S. [mailto:Richard.Myers@stites.com]
Sent: 17 November 2005 17:31
To: Steve Corcoran
Subject: RE: Ref; 1007 (P000) Mail

Steve:

Attached is a copy of the application from our end.

As you will see, it is the same as that which you previously reviewed.

Please confirm that you will continue to refuse to sign the Declaration and Power of Attorney.

Thanks,
Richard

Richard S. Myers, Jr.

STITES & HARBISON PLLC

424 Church Street, Suite 1800

Nashville, Tennessee 37219

Phone: 615-782-2333

Fax: 615-782-2371

richard.myers@stites.com

11/17/2005

11/17/2005